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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,786	03/06/2002	Junichi Kimura	2002_0273A	7157
513	7590	09/04/2003		EXAMINER
WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021			TRAN, THANH Y	
			ART UNIT	PAPER NUMBER
			2841	

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/090,786	KIMURA, JUNICHI
	Examiner Thanh Y. Tran	Art Unit 2841

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 May 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

4) Claim(s) 21-43 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 21-43 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 06 March 2002 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	6) <input type="checkbox"/> Other: _____.

## **DETAILED ACTION**

Applicant's arguments with respect to claims 21-43 have been considered but are moot in view of the new ground(s) of rejection.

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "internal layer", "internal pattern" and "a land" in claim 24 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 24 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to provide support for the limitations of “a land adjacent said electrode”, and “with said land being connected to said internal pattern and said electrode” (emphasis added).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24 is unclear as to what Applicant means by “an internal layer having thereon an internal pattern and a land adjacent said electrode, with said land being connected to said internal pattern and said electrode”? (emphasis added).

Claim 33 recites the limitation “said no portion” in line 3. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 21-27 and 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Kudoh et al (U.S. 6,373,714).

With respect to claim 21, Kudoh et al discloses a module (Figs. 4A-4C) comprising: a substrate (20) having a lateral side (as labeled in figure 4A), an upper side and a lower side (top and bottom side surfaces); a recess (see “recess” as labeled in figure 4A) in the lateral side; and an electrode (26) in the recess and spaced from the lateral side.

With respect to claim 22, figure 4A of Kudoh et al shows an electronic component (21) mounted on the substrate (20).

With respect to claim 23, figure 4C of Kudoh et al shows a land (see “land” as labeled in figure 4C), on the upper side, adjacent the recess and connected to the electrode (26); and a land (34), on the lower side, adjacent the recess and connected to the electrode (26). *WL 1, line 29 - 32*

With respect to claim 24, as best understood, figure 4C of Kudoh et al shows the substrate (20) comprises a multi-layer substrate that includes an internal layer (see “internal layer” as labeled in figure 4C); the substrate (20) having an internal pattern (as labeled in figure 4C).

With respect to claim 25, figure 4A of Kudoh et al shows another electrode (27) at the lateral side.

With respect to claim 26, figure 4A of Kudoh et al shows the substrate (20) has a corner, and further comprising another electrode (28) at the corner.

With respect to claim 27, figure 4A of Kudoh et al shows recess is formed from plural recesses that extend from the upper side (top side surface) to the lower side (bottom side surface).

With respect to claim 32, Kudoh et al discloses a module (Figs. 4A-4C) wherein leg is soldered to the electrode (see col. 1, lines 20-25).

With respect to claim 33, Kudoh et al discloses a module (Figs. 4A-4C) wherein the lateral side of the substrate (20) defines a surface, and the electrode (26) is spaced from the lateral side such that no portion of the electrode (26) is co-planar with the surface.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 28-31 and 34-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudoh et al (U.S. 6,373,714).

With respect to claims 28-31, figure 4C of Kudoh et al shows a shield case (22) covering the electronic component (21), the shield case (22) having a leg joined to the electrode (26); lateral side is positioned outwardly beyond the shield case (22); the shield case (22) has a lateral side (as labeled in figure 4C), with the lateral side of the substrate being substantially flush and parallel with the lateral side of the shield case (22). Figure 4B of Kudoh et al shows the shield case (22) has a lateral side (as labeled in figure 4C) and an upper side (see upper side" as labeled in figure 4C), with the lateral side of the shield case (22) being more textured than the upper side of the metal shield case (22). Kudoh et al does not teach the shield case is made of metal. However, one of ordinary skill in the art at the time the invention was made would provide a

shield case which is made of metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re leshin*, 125 USPQ 416.

Method claims 34-43 recite method steps which are deemed to be inherent upon the reference of Kudoh et al as applied above in claims 21-33.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh Y. Tran whose telephone number is (703) 305-4757. The examiner can normally be reached on Monday through Thursday and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin, can be reached on (703) 308-3121. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3431.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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